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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,759	06/21/2001	Gerald George Kiernan	ARC920010054	7480

22462 7590 08/10/2004

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EXAMINER

VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 08/10/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,759

Applicant(s)

KIERNAN ET AL.

Examiner

Jacques Veillard

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the applicant's communication filed on 6/21/2001.
2. Claims 1-24 are pending and presented for examination.
3. Claims 1, 9, and 17 are the independent claims. Other claims are the dependent.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 6/21/2001 (Paper No. 2) is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The self-join recited in the independent claims 1, 9 and 17 does not describe in the specification in a way to enable one having ordinary skill to make and use the invention. Applicant(s) does (do) not provide a definition as to what a self-join meant in the specification. Therefore, applicant(s) is/are advised to amend the specification or cancel the above-mentioned

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limitation from the claims. Furthermore, Applicant(s) is/are reminded that no new matter should be added.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Lyer et al.(U. S. Pat. No. 5,899,992, hereinafter Lyer).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

9. For the compact of prosecution claims 1, 9 and 17 will be rejected based on the best understanding of the examiner.

A recitation (e.g. “to eliminate the table expressions and to reduce the query to an equivalent query over tables”) of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As per claim 1, Lyer et al. disclose “a method for a computer implemented scaleable set oriented classifier” by providing the scalable set-oriented classifier stores set-oriented data as a table in a relational database (See Lyer et al. Title ; Abstract). In particular, Lyer et al. disclose the claimed limitations of “determining whether a query includes a self join that is transitively derived through table expression having union operators; and simplifying the query, when the query includes the self join that is transitively derived through the table expression having the union operators” (See Lyer et al. col9, lines 33-64).

As per claims 9 and 17, most of the limitations of the claims have been noted in the rejection of claim as substantially the same. Except that claim 9 is directed to a computer implemented apparatus and claim 17 to an article of manufacture. Therefore, they are rejected in similar ground corresponding to the arguments given for the rejected claim 1 above. In addition Lyer et al. disclose a apparatus and article of manufacture for a computer implemented (See Lyer et al. Abstract).

Allowable Subject Matter

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10. Claims 2-8, 10-16, and 18-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Other Prior Art Made Of Record

- | | |
|--|-------------------------------|
| 11. Li, Wen-Syan | U. S. Pat. No. 6,725,227, |
| Subramanian et al. | U. S. Pat. No. 6,546,381, |
| Agrawal et al. | U. S. Pat. No. 6,324,533, |
| Levy et al. | U. S. Pat. No. 6,711,560, |
| Bosworth et al. | U. S. Pat. No. 6,016,488, |
| Levy et al. | U. S. Pat. No. 6,721,725, |
| Srivastava et al. | U. S. Pat. No. 6,061,676, |
| Levy et al. | U. S. Pat. No. 6,745,174, |
| Al-omari et al. | U. S. Pat. No. 6,438,741, and |
| George Kock et al. Oracle: The complete Reference, third Edition; 1995, McGraw-Hill; | |
| Versions 7, 7.1, and 7.2; pp 253-266. | |

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. **Any response to this action should be mail to:**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 746-7239 (for formal communication intended for entry)

Or:

(703) 746-7240 (for informal of draft communications, please label

"PROPOSED" or "DRAFT")

Hand - delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington.

VA, Fourth Floor Lobby (Receptionist Telephone No. (703) 305-3900).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (703) 305-7094. The examiner can normally be reached Monday through Friday from 9:30 AM to 4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached on (703) 305-3830. The fax phone number for this group is (703) 308-5403.


CHARLES RONES
PRIMARY EXAMINER



Jacques Veillard
Patent Examiner TC 2100

August 3, 2004